

REMARKS/ARGUMENTS

Claims 1-6 stand rejected in the outstanding Official Action. Claims 1-3 have been amended and claims 7 and 8 added for consideration. Accordingly, claims 1-8 are the only claims remaining in this application.

The Examiner's confirmation of PTO receipt of Applicants' claim for foreign priority is very much appreciated. Additionally, the Examiner's indication of PTO acceptance of the previously filed formal drawings is appreciated.

Request for PTO Correction of the Record

Applicant has attempted numerous times to bring the attention of the Patent Office clerical staff to the fact that the PTO has continued to carry on its records an erroneous indication of the filing date of present application. In the most recent communication (filed March 11, 2009), Applicant again noted that the Corrected filing receipt mailed February 12, 2009 is still erroneous. It is noted that the present Official Action continues to carry the erroneous filing date information. The present application was actually filed on September 12, 2006 and communications from the US PTO should reflect the filing date of "09/12/2006," rather than the December 7, 2006 date indicated (12/07/2006). Applicant has previously provided copies of the postcard receipt proving the filing date of September 12, 2006 and has returned marked-up copies of the erroneous filing receipt.

It is respectfully requested that the clerical staff and/or the Examiner correct the PTO errors in this case so as to correctly reflect the actual filing date of the present application, i.e., September 12, 2006.

Response to Official Action

The Patent Office objects to the arrangement of the specification. It is noted that the objection to the arrangement appears to be an indication that the originally filed specification does not meet the formality requirements of the U.S. Patent and Trademark Office. The Patent Office is reminded that the U.S. Patent and Trademark Office must comply with all articles of the Patent Cooperation Treaty (PCT) including Article 27. It has been held that:

“if the rule and interpretation of the PTO conflicts with the PCT, it runs afoul of Article 27 of the PCT which provides in part:

- (1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.” Caterpillar Tractor v. Commissioner, 231 USPQ 590, 591 (EDVA 1986).

The Patent Office has referenced this decision in the Official Gazette dated September 9, 1986 (1070 TMOG 5).

As a consequence, the Patent Office may not require specification format changes as long as the originally submitted documents comply with the PCT requirements. Inasmuch as this specification was forwarded from WIPO, by definition, it meets the PCT requirements (it is not forwarded until it meets PCT requirements.). Therefore, the objection to the specification is respectfully traversed and reconsideration thereof is respectfully requested.

Notwithstanding the above, applicant has added headings and subheadings to the specification in the above amendment.

On page 3, first paragraph of the outstanding Official Action, the Examiner alleges that “applicant has not filed a certified copy” of the French priority application and that this is somehow required by 35 USC §119(b). As noted in the “Notice of Acceptance of Application

under 35 USC §371 and 37 CFR 1.495" mailed July 12, 2007, the PTO acknowledges the present application is a national phase entry of a PCT application and, as such, does not require submission of a certified copy of the French priority application to confirm the foreign priority. Should the Examiner wish to receive a copy of the French priority application, PTO procedure dictates that the Examiner contact the U.S. PTO PCT Receiving Office who in turn will contact WIPO to obtain a copy of the certified copy on record with WIPO and filed with the original filing of the PCT International application.

Whether or not the Examiner chooses to request a copy of the French priority document upon which the PCT International application is based, he may not require the submission of a certified copy of the French priority document in this national phase entry application. Should the Examiner believe otherwise and believe that this is supported by any change in the U.S. PTO requirements, he is respectfully requested to indicate the statutory or regulatory basis for such change.

Otherwise, conventional PTO procedure is to not require in a National Phase entry application any certified copy of a priority document upon which a PCT International application is based, as these documents are on record at WIPO. As noted in the MPEP, the Examiner should instead mark in the Office Action Summary Sheet that priority is claimed (box 12), that "all" (box a)) and then box "3" copies of the certified copies "have been received in this National Stage application from the International Bureau." As noted in the MPEP, it is improper for the Examiner to mark box 12(c) because this indicates that the PTO PCT Receiving Office has not done its job of requesting a certified copy of the priority document from WIPO.

It is respectfully requested that the Examiner note on any subsequent Office Action Summary that the PTO has received all copies of the certified copy of the priority document in this national stage application from the International Bureau (WIPO).

Claims 1-6 stand rejected under 35 USC §103 as being unpatentable over Potter (U.S. Patent 5,555,172), Zeinstra (U.S. Patent 4,827,520) and Weimper (U.S. Publication 2003/0074112). In order to establish a *prima facie* case of obviousness, the Examiner has the burden of providing evidence supporting two conclusions. The first conclusion is that each element of Applicant's claims is disclosed somewhere in the three-reference combination of Potter/Zeinstra/Weimper. Secondly, the Examiner also has the obligation of providing an explicit "analysis" of his reasons for picking and choosing elements from the various references and then combining them in the manner of Applicant's claims. Failure to meet the burden of proof of either of these two requirements comprises a failure to meet the PTO's burden of establishing a *prima facie* case of obviousness. As will be seen by the discussion below, the Examiner has failed to provide evidence to meet his burden of proof of both of these required elements of a *prima facie* case.

Prior to the detailed discussion, it may be helpful for the Examiner to understand the subject matter of Applicant's independent claims. As noted in the Background of the Invention, the utilization of mobile telephones on board vehicles by a driver of that vehicle generally involves the driver looking at a display and dialing the number from a keypad. This is simplified somewhat in the case where the display scrolls through a number of pre-entered telephone numbers which the driver then selects and dials (Background of the Invention, page 1, lines 7-12). There are "hands free" mobile telephones that will use a voice recognition system so that the driver merely states what is desired and the name that is to be called and the system will

make the call. As noted in Applicant's specification on page 2, lines 8-16, there are difficulties with voice recognition software and thus to avoid using voice recognition software, Applicant's invention is an alternative.

While a vehicle operator can manually scroll through a variety of dialing choices or options, his vision has to be diverted to a visual display illustrating the various options available. Applicant's invention avoids the driver having to divert his visual attention away from the road in front of him, by providing an audible message which is a voiced representation of the option selected by the pointer.

In other words, and as set out in Applicant's independent claim 1, the driver merely twists a two-directional rotary knob one way or the other to move up and down a list of options and wherever the pointer stops there is a voiced representation of that indicated option. The driver can hear what option is being indicated and can then implement that option by pressing on the rotary knob or continuing to move the pointer position until reaching a desired option. Accordingly, a driver, without taking his eyes off the road in front of him, can, by turning a knob and listening to the indicated option, place a call by merely pressing the rotary knob after making the appropriate selection.

Turning to the prior art cited by the Examiner, Applicant believes that no prior art reference contains any suggestion of Applicant's claimed "acoustic means for sending to the user an audible message comprising a voiced representation of the option selected by the pointer in response to said pointer being incremented or decremented." The Examiner is obligated under 35 USC §112 (6th ¶) to properly construe this portion of the claim as covering the corresponding disclosure in the specification and drawings and equivalents thereof.

In the Official Action on page 4, middle of the page, the Examiner alleges that this feature is taught in the Potter reference at column 10, lines 10-56. However, a review of this portion of column 10 contains no disclosure of any structure equivalent to Applicant's claimed "acoustic means." The cited portion of the column comprises two paragraphs in which the first paragraph discusses Figure 12 which displays names and numbers.

The first paragraph merely teaches that, in a conventional fashion, a user may scroll up or down through the display and then, by pressing enter, dial the desired number (column 10, lines 19-23). This requires the user to look at the scrolling display. The second paragraph in column 10 discloses a number of letters with rotation of a switch 22 moving a cursor amongst those letters. Actuation of a switch causes the indicated letter to be entered into the phone list. Again this use requires the user to look at the display. As stated at the bottom of the second paragraph, "[i]n this manner, the operator can relatively easily spell out a persons name and number for addition to the pre-programmed phone list for subsequent auto dialing." This is also conventional with respect to mobile telephones.

However, nowhere in either of the two paragraphs cited is there any indication of Applicant's claimed "acoustic means," i.e., a structure for providing a "voice representation of the option selected by the pointer." Should the Examiner believe otherwise, he is respectfully requested to identify that specific portion of the Potter reference which teaches an audio output which is a representation of one of a plurality of options selected by the user.

On page 5, section 5 of the Official Action, the Examiner finally admits that "Potter . . . doesn't specifically teach acoustic means suitable for sending to the user an audible message constituting a voiced representation of the option selected by the pointer." This admission is very much appreciated.

However, the Examiner then contends that Zeinstra teaches this feature admittedly missing from Potter and identifies Zeinstra at column 7, lines 16-35 and column 14, lines 8-18. A review of the two cited portions in Zeinstra will reveal that Zeinstra also fails to disclose any structure which could be considered to be covered by Applicant's "acoustic means."

The portion of Zeinstra cited at column 7 teaches a voice actuated control system for use in a vehicle. There is simply no audio feedback to the user to indicate any option selected. For example, column 7, lines 8-10 specifies that "[e]ach display includes visual prompts indicating words which can be spoken for a variety of control functions." In other words, the user must look at the display and then speak the desired words in order to obtain the desired control over the system. As stated at column 7, lines 23-29, "

"[b]y speaking any of the displayed words, after receipt of either the key word or an actuation of the push-to-talk switch, a more detailed display or subpage of the function selected will be sequenced onto the display for subsequent actuation by other verbal commands or by actuating the specific switches as shown for example in the radio page of Fig. 19. Thus, the system provides verbal control with backup manual control if desired."

There is no suggestion that the system disclosed in this portion of Zeinstra provides any "voiced representation of the option selected by the pointer in response to said pointer being incremented or decremented" as required by the pending claims (emphasis added).

Turning to column 14 of the Zeinstra reference, the discussion between lines 8 and 18 is with respect to a voice recognition system. Specifically, if a voice command is given and that command is not understood by the system, there is an audible prompt which says "did you say . . ." which then allows the operator to respond "yes" or "no." While this does provide clarification of audible inputs made by a user (as is typical with voice actuated control systems), it does not provide any voice representation of an option selected by the pointer. Merely

requesting clarification of a voice command is not a “voiced representation of the option” which is identified by the pointer in Applicant’s claimed invention.

Accordingly, even if Potter and Zeinstra were combined, there is no disclosure of Applicant’s claimed “acoustic means.” Should the Examiner believe otherwise, he is respectfully requested to identify the specific portion of the Zeinstra reference which teaches any audible “representation of the option selected.” It is this audible representation of the option selected which permits a driver using the present invention to keep his/her eyes firmly fixed on the road and avoiding dangerous visual distractions.

It is noted that the Examiner does not make any allegation that the Weimper reference contains any disclosure of Applicant’s acoustic means. Accordingly, even if Potter, Zeinstra and Weimper were combined, at least one feature of Applicant’s independent claim 1, i.e., the “acoustic means,” is simply missing from all three references and therefore missing from the combination of references. Thus, with respect to independent claim 1 and claims 2-6 dependent thereon, the Examiner has not met his evidentiary burden of showing that all claimed elements exist somewhere in the combination of references and therefore fails to establish the first leg of a *prima facie* case of obviousness.

In order to meet the second requirement of a *prima facie* case of obviousness, the U.S. Supreme Court has recently clarified the Examiner’s obligations. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), it was held that it is often necessary for a court to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace and the background knowledge possessed by a person of ordinary skill in the art in order to determine whether there was an apparent reason to combine

the known elements in the fashion claimed by the patent at issue. The Supreme Court held that “[t]o facilitate review, **this analysis should be made explicit.**” (emphasis added) *Id.* at 1396.

The Supreme Court went on to say that it followed the Court of Appeals for the Federal Circuit’s advice that “**rejections on obviousness grounds cannot be sustained by mere conclusory statements**; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” ((emphasis added) the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

The only statement made by the Examiner which purportedly meets his obligation is the allegation that it would be “obvious to one of ordinary skill in the art . . . to modify vehicular telecommunication system control of Potter to include the verbal confirmation as did Zeinstra.” However, this is a conclusory statement and has nothing to do with Applicant’s “acoustic means” nor does it suggest that either of the two references provide any audible “representation of the option selected” by a pointer.

The Examiner apparently concludes that one would be motivated to combine the two references because this “allows for a intuitive [sic]/hands free [sic] for the user to confirm selection without taking their eyes off the road.” However, as noted above, in the Potter system one must look at a display. In Zeinstra, and typical of voice command systems, one must request confirmation of an original voice command. Applicant’s claimed “acoustic means” does not utilize a voice command initially, but rather, a user manipulated selector and then provides “a **voiced representation of the option selected.**” While Zeinstra clearly does provide a voice output in response to an audible input, it does not provide a voice output to a manual input as set

out in Applicant's claims. Thus, even the Examiner's motivation with respect to combining the Potter and Zeinstra references is faulty.

In any event, the Examiner provides merely a conclusory statement which, as noted by the Supreme Court, is insufficient rationale for basing an obviousness rejection.

In view of the above, the Examiner fails to meet either of the tests of a *prima facie* case of obviousness and thus the burden remains with the Examiner to prove some basis for rejecting Applicant's claims 1-6. The Examiner has failed to meet that burden of proof and therefore claims 1-6 are clearly patentable over the Potter/Zeinstra/Weimper combination and any further rejection thereunder is respectfully traversed.

Applicant has also included newly written claims 7 and 8 directed to a device and method of providing **an audible indication of a chosen option** which is the crux of Applicant's invention. Because no prior art reference contains any disclosure of such structure or method, these newly written independent claims are believed patentable over the prior art of record. Entry and consideration of claims 7 and 8 is respectfully requested.

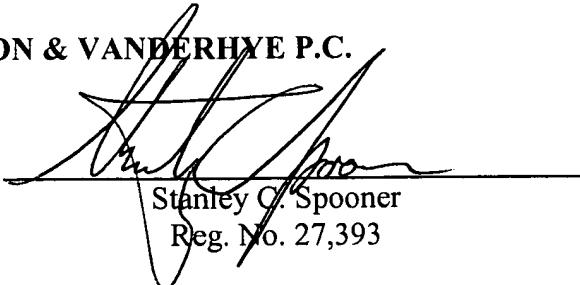
Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-8 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicant's undersigned representative.

SEYDOUX
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Respectfully submitted,

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